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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/682,657	10/09/2003	Jack Polonka	J6860(C)	8243
201 7590 09/30/2008 UNILEVER PATENT GROUP 800 SYLVAN AVENUE AG West S. Wing ENGLEWOOD CLIFFS, NJ 07632-3100			EXAMINER SOROUSH, LAYLA	
			ART UNIT	PAPER NUMBER
			1617	
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			09/30/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/682,657

Applicant(s)

POLONKA, JACK

Examiner

LAYLA SOROUSH

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The response filed June 20, 2008 presents remarks and arguments submitted to the office action mailed March 21, 2008 is acknowledged.

Applicant's arguments over the 35 U.S.C. 103(a) rejection of claims 1-3, 5-9, 11-13, 15-17, 19 and 20 over Nagatani et al. (US 2002/0176833) is not persuasive. Therefore, the rejection is maintained for the reasons of record.

Applicant's arguments over the 35 U.S.C. 103(a) rejection of claims 4, 10 and 18 over Nagatani et al. (US 2002/0176833) in view of Dreher (US 2003/0157041) is not persuasive. Therefore, the rejection is maintained for the reasons of record.

Applicant's arguments over the 35 U.S.C. 103(a) rejection of claims 13 and 14 over over Nagatani et al. (US 2002/0176833) in view of Tan et al. (US 6,511,672) is not persuasive. Therefore, the rejection is maintained for the reasons of record.

Upon further consideration of the claims the following additional rejections have been made:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-13 and 15-22 rejected under 35 U.S.C. 102(b) as being anticipated by Grollier et al. (US 5000937) as evidenced by Andrean et al. (5205837).

Grollier et al. discloses transparent cosmetic composition for protecting the human epidermis against infrared radiation, which comprises, in a cosmetically acceptable vehicle, an effective amount of at least one substance that reflects infrared radiation, dispersable in said vehicle, possessing a reflectance (R) of infrared radiation equal to at least 45%, and of which a 2% strength dispersion in vaseline possesses an optical transmission in the visible of at least 85%, selected from the group consisting of diatomite, hollow glass microspheres of particle size less than 100 microns, bismuth oxychloride of particle size less than 75 microns, and zirconium powder-covered ceramic microparticles of particle size less than 8 microns (claim 1). The transparent cosmetic contains 1 to 3% by weight, based on the total weight of the composition, of at least one infrared-reflecting agent (claim 6), in the form of a suspension or dispersion in solvents or fats, in the form of an emulsion or in the form of an ointment, a gel, a solid stick, or an aerosol. The form of a water-in-oil emulsion comprises in addition to the infrared-reflecting agent, fatty alcohols, fatty acid esters, fatty acids, lanolin, natural or synthetic oils or waxes, and emulsifiers, in the presence of water (claims 10 and 12). The bismuth oxychloride have an average particle size 6 to 15 microns, sold by the company MALLINCKRODT under the name "PEARL GLO."

Andrean et al. teaches "PEARL GLO" are lamellar (thin plate-like) in structure.

Products of identical chemical composition can not have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grollier et al. (US 500937) and Andrean et al. (5205837), as discussed in claims 1-13 and 15-22 above.

Although, Grollier et al. does not teach the specific benefit agents of claim 14, the reference does teach linoleates for the purpose of promoting oil retention; salicylates useful as UV screening agents capable of being used in the transparent cosmetic composition according to the invention.

Therefore, it would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to incorporate the specific benefit agents. One having ordinary skill in the art would have been motivated to do this to obtain the desired oil retention and UV screening properties of the composition as suggested by Grollier et al. Hence, a skilled artisan would have reasonable expectation of successfully producing a composition with similar efficacy and results.

Claims 1-3, 5-9, 11-13, 15-17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagatani et al. (US 2002/0176833).

Nagatani et al. teach pigmented and non-pigmented cosmetic compositions containing 0.1-30% by wt. of hollow plate metal oxide particles A (e.g. zirconium oxide) having an average particle diameter of 5-12 μm and 0.01-99% by wt. of inorganic

particles B (e.g. aluminum oxide, barium sulfate or boron nitride), having platy structure and a refractive index (RI) of 1.6 to 1.8 and a total transmittance of at least 85%. See [0016]-[0018], [0025], [0026], [0031], [0034], Examples. The compositions of Nagatani et al. have "an excellent feeling of transparency". See Abstract; Examples. The compositions contain other conventional cosmetic ingredients such as oil substances, antioxidants, moisturizers, surfactants, perfumes, etc. See [0049]-[0051]; Examples. Nagatani et al. does not explicitly teach the claimed opacity of the composition of less than about 20%. However, the compositions of Nagatani et al. have "an excellent feeling of transparency", "brightness" and "natural finish". See above. Therefore, it would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to determine an optimal or workable opacity of the composition by routine experimentation. One having ordinary skill in the art would have been motivated to do this to obtain the desired transparency and natural finish of the composition as suggested by Nagatani et al. With respect to Claims 6 and 20, the reference does not explicitly teach the claimed particle thickness. However, determination of optimal or workable particle thickness by routine experimentation is obvious absent showing of criticality of the claimed parameter. One having ordinary skill in the art would have been motivated to do this to obtain the desired transparency and natural finish of the composition.

Claims 4, 10 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagatani et al. (US 2002/0176833) in view of Dreher (US 2003/0157041), of record.

Nagatani et al. applied as above. Nagatani et al. do not teach bismuth oxychloride of Claims 4 and 18. However, Dreher teaches using plate-like bismuth oxychloride particles having an average particle size of 3-20 μm for the same purpose as boron nitride and barium sulfate powders of Nagatani et al. See [0010]. The compositions of Dreher provide soft, translucent glowing effect to the skin, which is due to the presence of the inorganic particles. See [0010]. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the compositions of Nagatani et al. such that to use bismuth oxychloride particles instead of boron nitride or barium sulfate particles. One having ordinary skill in the art would have a reasonable expectation of obtaining the same cosmetic emollient effect as set forth in the Nagatani et al. reference because these particles are used interchangeably for the same art-recognized purpose as suggested by Dreher.

Selection of a known material based on its suitability for its intended use is obvious absent a clear showing of unexpected results attributable to the applicant's specific selection. See e.g., *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). With respect to Claim 10, Nagatani et al. do not explicitly teach the particles suspended in a polar solvent prior to incorporation in the composition as claimed herein. However, Dreher teaches making optical make-up compositions for minimizing skin flaws by first suspending bismuth oxychloride and other inorganic particles in butylene glycol (polar solvent), then adding the mixture to the water (polar solvent) and pigments mixture; and then mixing the resulting water phase (with pigment particles suspended in it) with the oily phase. See Example 1 @ pp. 2-3. The compositions of Dreher, when applied to the

skin, give a high feeling of transparency, hide imperfections and give natural feeling and appearance of the skin. See [0004]. Therefore, it would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings of Nagatani et al. such that to suspend their platelet particles in polar solvents before incorporating the particle into the composition. One having ordinary skill in the art would have been motivated to do this to obtain imperfection-concealing compositions having natural skin feel and appearance as suggested by Dreher.

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagatani et al. (US 2002/0176833) in view of Tan et al. (US 6,511,672), of record.

Nagatani et al. applied as above. While teaching skin benefit agents, Nagatani et al. do not explicitly teach the specific benefit agents of the instant claim. However, Tan et al. teach skin benefit agents such as vitamins (e.g. vitamin A or retinol, vitamins C and E), skin lightening agents, alpha- or beta-hydroxy acids, etc. in skin imperfection-concealing compositions. See col. 7, lines 32-64. Therefore, it would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to modify the compositions of Nagatani et al. such that to employ retinol or other skin benefit agents of Tan et al. for their art-recognized purpose. One having ordinary skill in the art would have a reasonable expectation of beneficial results such as an antioxidant effect.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Response to Arguments

Applicant's response filed 6/20/08 are drawn to the same arguments previously made and have been fully considered but they are again not persuasive. For applicant's convenience the arguments are re-addressed below:

The Applicant argues: The '833 reference merely discloses a cosmetic composition having metal oxide plate powder with a hollow structure. The cosmetic composition provides a feeling of transparency by causing a remarkable change in hue. Paragraph 27 of the '833 reference clearly mentions that when inorganic powder having a refractive index of 1.6-1.8 is used, such a component is used at a concentration of 20% by weight. Applicant respectfully points out to the Examiner that when particles having an index of refraction of 1.8-2.2 are used in the composition of the invention as claimed, about 0.01% to about 1.0% by weight of the solid single- crystal, flat, platy particles are used. Twenty percent (20%) is not used as described in the '833 reference. Furthermore, the cosmetic compositions described in the '833 references require hollow plate powder (A) so that various color tones may be prepared. The present invention, again as now presented, does not require hollow plate powders to generate various color tones. In fact, the compositions of the present invention provide a radiant appearance to skin and a colorless or natural skin finish. In view of the above, it is clear that all of the important and critical limitations set forth in the presently claimed invention are not found in the '833 reference. Therefore, the rejection made under 35 USC §103 should be withdrawn and rendered moot." See p. 8 of the reply.

In response the following is noted: (1) the instant claims do not exclude the presence of additional ingredients, such as hollow particles. The claim language "consisting essentially of" does not exclude the presence of additional components unless the Applicants provide an evidence that the presence of those additional components "would materially affect the basic and novel characteristics of the claimed invention." See MPEP 2111.03 citing *In re Hertz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). The Applicant presented no evidence that the presence of hollow particles would materially affect the basic and novel characteristics of the claimed invention. According to MPEP 2111.03 (citing *In re De Lajarte*, 337 F.2d 870, 143

USPQ 256 (CCPA 1964)), the Applicant "has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention." Further, it is noted: (2) the Nagatani reference clearly teaches that the content of platy particles (B) in the cosmetic composition "is preferably 0.01 to 99% by weight." See [0034]. The above-referenced paragraph [0027] merely exemplifies one of the preferred embodiments of the Nagatani's invention.

In response to the Applicant's argument that "[s]ince the amount [of particles] employed in the compositions of the '833 reference is significantly higher than those claimed in the present inventions, the combination of the '833 reference with the '041 reference does not render the claimed invention obvious" (see pp. 10-11 of the reply), it is noted that the Nagatani reference teaches the broad concentration range of 0.01-99% by weight of the platy particles as discussed above. It would have been obvious and within skill of the ordinary practitioner to select optimal or workable concentration of the particles within the broader range taught by the reference in order to achieve the desired optical and cosmetic properties of the composition.

In response to the Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

No claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Layla Soroush whose telephone number is (571)272-5008. The examiner can normally be reached on Monday through Friday from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/SREENI PADMANABHAN/
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